

E-FILED 03-16-2010

NOT FOR CITATION
IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

GREGORY BENDER,

No. C09-02112 JW (HRL)

Plaintiff,

**ORDER DENYING INFINEON
TECHNOLOGIES' MOTION TO
STRIKE AND GRANTING INFINEON
TECHNOLOGIES' MOTION TO
COMPEL**

v.

[Re: Docket No. 26]

INFINEON TECHNOLOGIES NORTH
AMERICA CORP.; NXP SEMICONDUCTORS
USA, INC.; ON SEMICONDUCTOR
CORPORATION; and SILICON
LABORATORIES, INC.,

Defendants.

Plaintiff Gregory Bender sues for alleged infringement of his U.S. Patent No. 5,103,188 (the “188 patent”), which concerns circuits for amplifying complex or high speed signals. Defendant Infineon Technologies North America Corp. (“Infineon”) moves to strike Bender’s infringement contentions, or alternatively, to compel amended contentions. Upon consideration of the moving and responding papers, as well as the arguments presented at the March 16, 2010 hearing, this court denies Infineon’s motion to strike and grants Infineon’s motion to compel.

Patent Local Rule 3-1 requires a plaintiff in a patent infringement action to serve infringement contentions setting forth “[e]ach claim of each patent in suit that is allegedly infringed by each opposing party” and identifying for each asserted claim “each accused

apparatus, product, device, process, method, act, or other instrumentality (“Accused Instrumentality”) of each opposing party of which the party is aware.” PATENT L.R. 3-1(a), (b).¹ A plaintiff must also provide a “chart identifying specifically where each limitation of each asserted claim is found within each Accused Instrumentality, including for each limitation that such party contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function.” *Id.* at 3-1(c).

Patent L.R. 3-1 is essentially a “discovery device” intended to streamline the discovery process by taking the place of a series of interrogatories that defendants would likely have propounded. Network Caching Technology LLC v. Novell, Inc., No. C01-2079VRW, 2002 WL 32126128, *3-4 (N.D. Cal., Aug. 13, 2002). As such, a plaintiff is required to include its in infringement contentions all facts known to it, including those discovered in its Fed. R. Civ. P. 11 pre-filing investigation. *Id.* at *4. The Rules are designed to require parties to crystallize their theories of the case early in the litigation and to adhere to those theories once they have been disclosed. Alberta Telecommunications Research Centre v. Rambus, Inc., No. C06-02595RMW, 2007 WL 4170564 *1 (N.D. Cal., Nov. 19, 2007); Atmel Corp. v. Info. Storage Devices Inc., No. C95-1987 FMS, 1998 WL 775115 *2 (N.D. Cal., Nov. 5, 1998).

In this case, plaintiff reportedly accuses some 600 Infineon products of infringement. In his infringement contentions, he divides the accused products into several categories titled: “Cellular RF Transceivers,” “Mobile Phone Platforms,” “Tuner ICs and Demodulators,” “Wireless Communication Products,” “Mobile Phone Baseband ICs,” “Integrated Power Amplifiers,” and “Micro-Controllers with built-in ADC Channels.” (Foster Decl., Ex. M). Plaintiff has served claim charts only as to five products which he claims are “representative” of the 600 or so that have been accused. The claim charts further divide those five products into the following categories: “Transceivers,” “Tuner ICs and demodulators,” “Wireless

¹ Because the instant action was filed prior the December 1, 2009 amendment of the Patent Local Rules, the Patent Local Rules in effect on November 30, 2009 apply.

1 Communication Products, RF Power Products, RF Power Amplifiers,” “USB Audio,” and
2 “Microcontrollers with Analog Processing Circuitry.” (Id., Ex. L).

3 At this juncture, this court is not prepared to strike Bender’s contentions, and
4 defendant’s motion to strike is denied. Nonetheless, defendant’s alternate motion to compel is
5 granted because this court agrees that Bender’s infringement contentions fail to comply with
6 Patent L.R. 3-1. To begin, Bender has made no showing that his use of “representative” claim
7 charts is proper. Other than plaintiff’s bare assertion, there is nothing in the record presented
8 indicating, for example, that the five products for which plaintiff provided claims charts share
9 common circuitry with the other accused products. Further muddying the waters is plaintiff’s
10 grouping of the accused products into rather broad and amorphous categories that, on their face,
11 do not appear to readily correspond to the labels used in his claims charts.

12 Additionally, plaintiff’s infringement contentions are impermissibly vague. Bender has
13 done more than merely parrot the claim language. But his claims charts provide generic
14 allegations that do not identify specific circuitry or components that reportedly correspond to
15 the claim limitations — or, at least, not in a manner that gives defendant fair notice as to where
16 the alleged infringing circuits are located. Instead, Bender simply repeats the same generic
17 descriptions and cuts-and-pastes them beside each element of every claim. Plaintiff contends
18 that defendant’s engineers should be able to not only understand the terms used in his
19 infringement contentions, but also readily locate the subject circuitry in Infineon’s accused
20 products. He suggests that the next step in this case should be for defendant to produce detailed
21 schematics, asserting that he cannot provide more detailed infringement contentions without
22 them. Suffice to say that Bender (not defendant) bears the burden of identifying specifically
23 where each and every claim element is found within the accused products. And, this court finds
24 that plaintiff’s infringement contentions need to be much improved before he can proceed.

1 Accordingly, Bender will be given until March 26, 2010² in which to amend his
2 contentions to (a) demonstrate that “representative” products are accurate representations of the
3 hundreds of other accused products and (b) provide specific locations within defendant’s
4 products where the alleged infringement occurs. Although the court has declined to strike
5 plaintiff’s contentions at this time, they may well be stricken in the future if they continue to be
6 insufficient.

7 SO ORDERED.

8 Dated: March 16, 2010


9 HOWARD R. LLOYD
UNITED STATES MAGISTRATE JUDGE

United States District Court
For the Northern District of California

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27 ² This ruling is based upon the court-ordered case management deadlines.
28 Plaintiff states that he is willing to stipulate to an extension of those deadlines. If the
presiding judge concludes that an extension is warranted, this court finds that plaintiff should
have 30 days in which to amend his infringement contentions.

1 5:09-cv-02112-JW Notice has been electronically mailed to:

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